

**REMARKS**

This application has been carefully reviewed in view of the above-referenced Office Action, and reconsideration is requested in view of the following remarks.

**Request to Remove the Finality of the Rejection**

In view of the clear errors in the claim rejections and reference combinations pointed out below, Applicants submit that *prima facie* obviousness has not been established and Final Rejection is improper at this stage. Removal of the finality is respectfully requested.

**Regarding the Rejections in General**

Claims 1-19 were previously rejected based upon the combination of Zdepski and Tiwara of record.

Regarding claims 1-19:

Applicant appreciates the Examiner's Response to Arguments which provides insight into the present rejections. However, Applicant respectfully traverses.

While the undersigned applauds the Examiner's ingenuity in reversing the order of the Zdepski and Tiwari references, the undersigned submits that the order is of no consequence. The MPEP at 2145 X 2 explicitly states that "**References Cannot Be Combined Where Reference Teaches Away from Their Combination**" and "It is improper to combine references where the references teach away from their combination."

It is noted that the Office admits that Zdepski teaches away from index lookups" (page 2, second paragraph of current Final Office Action). The fact that the order has been reversed does not change that. The MPEP forbids the combination.

The Office asserts that Applicants have made admissions regarding Fig. 2 of the application. Applicant wishes to assure that the record is clear that any such admission is that two trick play files (one forward and one reverse) are known which use the I frames from the main content file. Two indices are used to match the two trick play files to locations in the main content file.

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Applicants further submit that the Tiwari reference teaches against use of the types of trick play files of Fig. 2 and of Zdepski. Tiwari teaches that use of trick play files containing I frames from the main content file causes "jerky picture quality because of the uneven spacing of the I-picture spacing" (col. 1, lines 43-46). He solves this problem by selecting every  $n^{\text{th}}$  and converting that picture (if B or P pictures) to an I picture. This collection of pictures is then used for a smooth trick play mechanism. Hence, use of Tiwari in conjunction with a trick play file made of I frames from the main content would not only fly in the face of Tiwari's teachings of the disadvantages of such I-frame trick play files, but would in fact destroy Tiwari's main function. Applicant notes that MPEP 2143.01 V. states that **"THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE"** and "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." Ergo, the proposed modification is further improper and *prima facie* obviousness has not been established.

As a result, not only does Zdepski teach against use of Tiwari's indices, Tiwari teaches against Applicants' Fig. 2 and Zdepski's trick play files. Moreover, use of Zdepski's trick play files or Applicants' Fig. 2 files in Tiwari would destroy the intended function of Tiwari. Hence, all possible permutations of proposed combination of teachings are wholly improper to form a viable case of *prima facie* obviousness.

Reconsideration and allowance of claims 1-19 are respectfully requested at an early date.

Regarding claims 19-27 and 44:

Claims 19-27 and 44 were rejected as obvious based on the combination of Boyle, Tiwari and Lev. Applicant further traverses the present rejection as follows:

The Office Admits at page 14, first paragraph that Boyle and Tiwari do not explicitly teach "storing the inter-coded frames of the content in a first file and storing the intra-coded frames of the content in a second file and where, commands received at the television service provider from a subscriber terminal requesting trick play modes are implemented by retrieving inter-coded frames from the first file using either the forward or the reverse indices". The Office

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looks to the Lev reference to supply these teachings. The Office then proceeds to explain how it believes the Lev reference to supply these teachings. However, one must analyze the claim language to recognize that the claims call for “storing the inter-coded frames of the content in a first file” and that the last sub-paragraph of the claim calls for retrieving the inter-coded frames from the first file using either the forward or reverse indices (emphasis added).

The Examiner’s attention is again drawn to the fact that the claim calls for use of the inter-coded frames of the content to be directly used to create trick play. However, Tiwari explicitly wishes to avoid the use of the content’s inter-coded frames directly so as to not produce jerky trick play and therefore creates another set of pictures for trick play. Hence, again the proposed combination destroys the intended function of the Tiwari reference. Per MPEP 2143.01, this is improper and *prima facie* obviousness has not been established. In view of this error, claims 19-27 and 44 are improperly rejected. Reconsideration and allowance are respectfully requested at an early date.

#### **Concluding Remarks**

The undersigned additionally notes that many other distinctions exist between the cited art and the claims. However, in view of the clear distinctions pointed out above, further discussion is believed to be unnecessary at this time. Failure to address each point raised in the Office Action should accordingly not be viewed as accession to the Examiner’s position or an admission of any sort. No amendment made was for the purpose of narrowing the scope of any claim unless an argument has been made herein that such amendment has been made to distinguish over a particular reference or combination of references. Applicants reserve the right to make further arguments favoring patentability of any claim at a future date.

#### **Interview Request**

In view of this communication, all claims are now believed to be in condition for allowance and such is respectfully requested at an early date. If further matters remain to be resolved, the undersigned respectfully requests the courtesy of an interview. The undersigned can be reached at the telephone number below. The undersigned wishes to work with the

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Examiner toward resolution of any outstanding issues and expedite prosecution of the present application. Hence, the courtesy of a telephone call to expedite further prosecution is earnestly solicited.

Respectfully submitted,

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Dated: 8/6/09

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